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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,391	03/18/2004	Ralph C. Gray	1656D1	5514

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PPG INDUSTRIES, INC.
Intellectual Property Department
One PPG Place
Pittsburgh, PA 15272

EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/803,391

Applicant(s)

GRAY ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-28 is/are pending in the application.
- 4a) Of the above claim(s) 17-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 16-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/5/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 16-20, drawn to an aqueous-based composition comprising the reaction product of an epoxy polymer and a phosphorus acid groups-containing compound, a curing agent, an electroconductive pigment and water, classified in class 523, subclass 416.
 - II. Claims 21-24, drawn to an organic solvent-based composition comprising the reaction product of an epoxy polymer and a phosphorus acid groups-containing compound, a curing agent, an electroconductive pigment and an organic solvent, classified in class 523, subclass 456.
 - III. Claims 25-28, drawn to a process for coating a continuous metal sheet, classified in class 427, subclass 407.1.

The inventions are distinct, each from the other because:

2. Invention I is distinct from Invention II since the water of Invention I is a materially different diluent from the organic solvent of Invention II. The water forms an emulsion of the components which is rheologically different from the dissolved components using the organic solvent of Invention II.
3. Inventions (I or II) and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)).

In the instant case, the product as claimed can be used in a materially different process of using that product such as a method of bonding two substrates.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

- 1) The epoxy-containing polymers.
- 2) The phosphorus acid groups-containing compounds.
- 3) The curing agents a.ii.
- 4) The electroconductive pigments.
- 5) The presence or absence of the stabilizers, dispersants and thickeners of claim 17, wherein if their presence is elected, particular species thereof are identified such as the potassium tripolyphosphate of claim 18.
- 6) The presence or absence of the amine of claim 19 and/or the corrosion inhibiting pigments of claim 20, wherein if their presence is elected, particular species thereof are indicated.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 16-28 are generic.

A reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. During a telephone conversation with William J. Uhl on December 7, 2004, a provisional election was made with traverse to prosecute Invention I, and the following species:

- 1) A polyglycidyl ether of bisphenol A.
- 2) Phosphoric acid.
- 3) An aminoplast.

4) Iron phosphide.

5) The absence of the stabilizers, dispersants and thickeners of claims 17 and 18, the absence of the amine of claim 19, and the absence of the corrosion inhibiting pigments of claim 20.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 21-28 are withdrawn from further consideration under 37 CFR 1.142(b) as being drawn to non-elected inventions. Claims 17-20 are withdrawn as being directed to the presence of the stabilizers, dispersants and thickeners of claims 17 and 18, the amine of claim 19, and the corrosion inhibiting pigments of claim 20.

6. The specification on page 1 referring to the preliminary amendment filed March 18, 2004 should be amended to update the status of parent application no. 09/858,280 as U.S. Patent No. 6,750,274.

7. The claims of the instant application differ from those allowed in parent application no. 09/858,280 only in the presence of water. Accordingly, the 35 U.S.C. 103(a) rejection over the closest prior art of Berger et al. Patent No. 6,440,580 and Young, Jr. et al. Patent No. 4,346,143 is not applicable to the instant claims for the same reasons as espoused on page 3 of the Notice of Allowability for the parent application.

The secondary reference to Japanese Patent No. 7-331164 ascribes the motivation for employing the phosphoric acid-modified epoxy resin to apply only when present in an amount of from 0.1 to about 20 weight percent which is outside of the higher amounts of epoxy resin taught by Young, Jr. et al.

8. Soltwedel Patent No. 6,008,462 is directed to a weldable coating containing a phosphoric acid-epoxy resin reaction product which is organic solvent-based as opposed to the claimed presence of water.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claim 16 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 9, 20 and 23 of U.S. Patent No. 6,641,923. Although the conflicting claims are not identical, they are not patentably distinct from each other. The claims of the patent set forth a coating composition comprising a phosphatized epoxy group-containing polymer, a curing agent, an electroconductive pigment, a reaction product of a boron-containing compound and a polysiloxane, and a boron-containing compound. The electroconductive pigment is dispersed in the binder composed of the epoxy polymer and curing agent in a weight ratio of from 0.5:1 to 9.0:1 (claim 2).

10. The claimed presence of water is not recited. It would have been obvious disperse the components of the coating into water in order to facilitate the ability to coat the composition without resorting to the use of environmentally hazardous volatile organic solvents.

11. Claim 16 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-4, 9-11, 13, 14, 18, 20 and 21 of copending Application No. 10/288,791. Although the conflicting claims are not identical, they are not patentably distinct from each other. The claims of the copending application are directed to a weldable composition comprising a binder containing a reaction product of an epoxy polymer and a phosphorus-containing compound (claim 2) and a curing agent (claims 9-11) combined with a conductive pigment in a weight ratio of pigment:binder of from 0.2:1 to 10:1 (claim 18). The weldable coating is aqueous-based (claim 21).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Monday to Friday from 9:30 to 6:00 EST

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